
IN THE
Supreme Court of the United States

OCTOBER TERM, 1976

No. 76-488

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SUPREME COURT, U.S.

ROANWELL CORPORATION

Petitioner,

v.

PLANTRONICS, INC.

Respondent.

**BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

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There is no issue of special public significance in this case.

The case was correctly decided below.

Accordingly the petition should be denied.

* * *

**I. THERE WAS FULL REVIEW IN THE
COURT OF APPEALS**

Petitioner has urged that this Court should grant certiorari because the Court of Appeals did not consider all issues Petitioner presented. (Petition, pp. 4, 13-15)

The issues were briefed thoroughly and argued to the Court of Appeals, one of them being separately presented a second time on Motion for Rehearing. The district court had written a lengthy opinion, and the Court of Appeals wrote a *per curiam* opinion agreeing with it.

That the Court of Appeals did not elect to *write* on every issue it considered is clearly no ground for grant of certiorari. Rather, the failure of Courts to write on frivolous issues is sound judicial policy.

Next, Petitioner urges that the Court of Appeals abdicated its judicial function in favor of the learned trial judge, because he was an expert in technology. Therefore (so the argument implies), the appellate tribunal needs to have its knuckles wrapped.

But the Court of Appeals heard a longer-than-normal oral argument, considered unusually lengthy briefs, and found in its own phrase — a phrase not used by the trial court — that

“the Larkin patent constituted a major breakthrough in the art for lightweight headsets. . . .” (App. 30a)

The Court of Appeals also clearly applied the standards of this Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), restated and followed by this court in *Sakraida v. Ag Pro Co.*, U.S., 96 S.Ct. 1532 (1976).

It surely is false to allege that a Court of Appeals is barred from finding that “the record amply supports” the trial court’s findings. A court so finding should not be charged with failure to give adequate judicial review.

There is no evidence of improper judicial review by the Court of Appeals.

II. PETITIONER'S NOVEL THEORY OF UNENFORCEABILITY IS CONTRARY TO SETTLED LAW

Defendant, the pirate of Plaintiff's United States patent, now seeks to justify its piracy by virtue of allegations unproved (there has been no trial on these issues) of fraud on the British Patent Office and a European license under the British patent.

The Court of Appeals did not think enough of the issue to justify writing upon it, even after Motion for Rehearing addressed specifically to that point. Why?

This is a suit by a U. S. plaintiff upon a U. S. patent untainted by any fraud or misuse.

The British licenses never resulted in any commercial market development by any British licensee — the licensee failed substantially to produce. So the licenses never precluded export to the United States, though Plaintiff's valid patent rights in the United States would lawfully have prevented U. S. importation if satisfactory devices had ever been made by the licensee.

The last of the licenses was terminated in 1972 for failure of the licensee to make and sell.

Patent misuses can be purged. Even if a misuse occurred, it does not render patents unenforceable; not other, non-misused patents, and certainly not after the effects, if any, have been dissipated. See *Metals Disintegrating Co. v. Reynolds Metals Co.*, 228 F.2d 885 (3rd Cir. 1956).

Here, no effects ever occurred, owing to the licensee's non-performance. Further: All issues concerning the British patent and license were terminated long prior to the adjudication below, and hence were moot at trial and are even more so by now.

No misbehavior is even alleged under United States law or practice, or affecting this defendant who comes here quoting scriptures for its own piracy purpose.

The law is settled that:

1. There cannot be "misuse in the air"; the misuse must be of the patent in suit. *Kolene Corp. v. Motor City Metal Treating, Inc.*, 440 F.2d 77, 85 (6th Cir.), *cert. denied*, 404 U.S. 886 (1971).

2. Even alleged misrepresentations to the U.S. Patent Office during prosecution of one U.S. application do not affect a related U.S. application. *Noll v. O. M. Scott & Sons Co.*, 467 F.2d 295, 302-03, n. 6 (6th Cir. 1972), *cert. denied*, 411 U.S. 965 (1973).

3. Misstatements to a foreign Patent Office are irrelevant to patent proceedings in this country. *S. H. Kress & Co. v. Aghnides*, 246 F.2d 718, 725 (4th Cir.), *cert. denied*, 355 U.S. 889 (1957).

No social purpose would be served by forcing a United States trial under British law, of factual issues which occurred in Britain, and which came to naught without effect upon commerce either here or abroad.

The trial court's opinion striking the defense founded upon alleged foreign wrongs, affirmed by the Court of Appeals, was clearly correct.

No United States public interest commands this court to give its time to consider such irrelevant, moot, and foreign issues here raised by Petitioner.

III. THE STANDARDS OF PATENTABILITY APPLIED HERE ARE IN FULL ACCORD WITH THIS COURT'S DECISIONS

Petitioner makes esoteric arguments of alleged over-focus by the trial court, repeated by the Court of Appeals,

upon factors *Graham* called "secondary factors" of evidence of nonobviousness.

But here it is uncontested that at invention time Defendant itself was a well-established manufacturer of headsets which used each of the individual elements of the Larkin invention, a microphone transducer, a tube to the mouth, and an ear transducer, and a tube to the ear. And when asked by United Air Lines to solve its long-felt need for a lightweight headset that would not cause headaches and sore ears for its pilots and radio operators, Defendant tried but failed to solve the problem.

Defendant's expert witness at trial had been one of the Air Force's "Panel of Experts" convened in 1956 to solve the "headaches" and "ear torture" problems as critical to the Air Force pilots and air traffic controllers as to the airlines. This Panel had listed all the component parts available for it to work with in seeking a solution, including the individual parts used by Larkin in making his invention over five years later.

But the Panel of Experts failed to solve the Air Force's problem.

And Defendants' trial expert witness? He made over a hundred headsets, he put parts together a hundred times, and quit—defeated—without solving the Air Force's problem.

Larkin solved the problem. No wonder the Court of Appeals held

"the record amply supports the finding that the Larkin patent constituted a major breakthrough in the art . . ." (App. 30a).

There was synergism enough in the Larkin invention so that by the special way of fitting parts together (parts

actually known to those who tried and failed), severe headaches and ear soreness of pilots, air traffic controllers and telephone operators the nation over were relieved by Larkin's assembly of the parts when not relieved by Defendant's design efforts, or by the Air Force Panel of Experts, or many others whose efforts are in the record. Two plus two by Larkin's unique arrangement equalled a full six — four parts *plus* relief of headaches and sore ears of severity to those who must wear headsets for work-day employment.

Against such a background of the nation's greatest experts, and the Petitioner itself having been squarely presented with the problem and failing to solve it even though they were aware of the prior art parts, the trial court found the invention "nonobvious," and "an elegant and ingenious solution." (App. 15a). The Court of Appeals found it to be a "major breakthrough" (App. 30a) and affirmed.

To nit-pick the weight to be put upon various evidentiary factors, is not to change the inescapable conclusion correctly found: The invention was nonobvious — which is all the statute or this Court requires for patentability.

If those of skill in the art, once being aware of both the problem and the prior-art components to solve it, are not able to bring the invention into public enjoyment even when requested to do so, then there inherently exists a public need for a patent-system inducement for others to risk their money and perspiration, to try their inspiration where those first people have failed. Only by such patent-inducement can the public have timely enjoyment of progress in the useful arts.

Such was the effect of this Court's writing in *Graham* and again more recently in *Sakraida*: Correctly applied below.

CONCLUSION

The decision below being in accord with the law of this Court, and there being no new issue of significant public moment for this Court to address, the Petition should be denied.

Respectfully submitted,

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